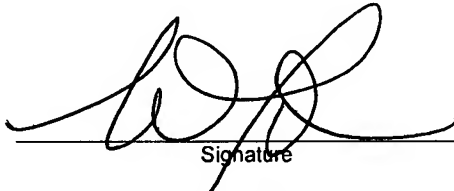




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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) AST-0001	
	Application Number 10/828,500-Conf. #4294	Filed April 21, 2004	
	First Named Inventor John D. Robinson		
	Art Unit 2157	Examiner H. A. El Chanti	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>40,290</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <div style="text-align: right;"> _____ Signature Christopher M. Tobin _____ Typed or printed name <u>(202) 955-3750</u> _____ Telephone number <u>December 19, 2008</u> _____ Date</div>			
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			



Docket No.: AST-0001
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
John D. Robinson

Application No.: 10/828,500

Confirmation No.: 4294

Filed: April 21, 2004

Art Unit: 2157

For: FILTERING AND MANAGING ELECTRONIC
MAIL

Examiner: H. A. El Chanti

REQUEST FOR PRE-APPEAL BRIEF PANEL REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

This request for Pre-Appeal Panel Review is in response to the Final Office Action dated June 19, 2008 and received in this application. Applicant has concurrently filed a Notice of Appeal regarding all outstanding grounds of rejection and will file an Appeal Brief in due course. However, it is anticipated that Panel Review will obviate the need for the filing a Brief.

Claims 15-23 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 6,275,850 to Beyda et al. ("Beyda"). This rejection is traversed.

Claim 15 has been amended and now recites: *[a] method for restoring electronic mail messages to a mail server, the method comprising:*

determining that an electronic mail message addressed to a particular user is resident at a mail server;

receiving the electronic mail message at a mail client from the mail server pursuant to an electronic mail downloading procedure that entails deleting the electronic mail message from the mail server;

receiving a request to restore the electronic mail message on the mail server following a completion of the electronic mail downloading procedure; and

restoring the electronic mail message as though the electronic mail message had not been downloaded from the mail server in response to receiving the request.

These claimed features are neither disclosed nor suggested by Beyda. Beyda discloses techniques for managing attachments to electronic messages. Beyda discloses that attached files satisfying a prescribed requirement are automatically downloaded from the server to a user's client device. Examples of prescribed requirements include maximum file size, download time, approved file formats, and approved senders. Also, when forwarding electronic messages with attached files, only the attached files that have been modified are uploaded from the client device to the server.

Applicant respectfully submits that Beyda is clearly distinct from Applicant's claimed invention. Beyda deals with the management of attachments. There is no mention of the downloading messages and restoring such messages on the server in any fashion whatsoever.

In any event, even if one were to inappropriately view the attachment as the "electronic mail message," there is still no deletion and restoration of the attachment. Rather, in Beyda, the attachment remains at the local server. When a message is forwarded with an unchanged attachment, that unchanged attachment is simply affixed to the forwarded message (this is believed to be ordinary e-mail forwarding). This procedure is in no way restoration of an electronic mail message.

In another process of Beyda, when a user forwards an electronic message with a modified attachment, the modified attachment is uploaded to the server as part of the forwarded message. First, it should be noted that forwarded messages are different messages, not restored messages. Also, when an attachment is modified, Beyda describes it as a different file altogether.

That different file is uploaded to the server when a person forwards a message with the modified attachment.

Applicant submits that Beyda merely describes typical e-mail forwarding and has nothing to do with Applicant's claimed invention, which involves restoration of electronic mail messages on the mail server after a user has received the message at a mail client from the mail server, and the electronic message has been deleted from the mail server.

With specific reference to the claims, there are thus various features that are clearly not disclosed or suggested by Beyda. In particular, there is no description of (1) *receiving the electronic mail message at a mail client from the mail server pursuant to an electronic mail downloading procedure that entails deleting the electronic mail message from the mail server*; (2) *receiving a request to restore the electronic mail message on the mail server following a completion of the electronic mail downloading procedure*; and (3) *restoring the electronic mail message as though the electronic mail message had not been downloaded from the mail server in response to receiving the request*.

With regard to “*receiving the electronic mail message at a mail client from the mail server pursuant to an electronic mail downloading procedure that entails deleting the electronic mail message from the mail server*,” the Action alleges that column 7, lines 7-60 and column 8, lines 27-34 describe such a feature. However, a review of these passages merely reiterates what is stated above. The first passage describes FIG. 3, elements 48-52, which pertain to transmitting e-mail having an attachment from a remote device to a local server and then accessing such an e-mail by a receiving party, wherein the attached file is automatically downloaded depending upon filter conditions.

The Final Action alleges that the claim language does not explicitly state that the e-mail is deleted from the server, but this is incorrect. The plain and ordinary meaning of the term *entails* in the claim means that deleting the electronic message from the mail server is necessarily a part of the downloading procedure. It is hard to envision how deleting can be construed as absent from the claim given the plain and ordinary meaning of the claim language, and Applicant respectfully requests evidence regarding this apparently novel construction of the term entails.

There is no mention whatsoever of the type of procedure wherein the electronic mail message is deleted from the mail server when the e-mail is received at the mail client. However, even if one assumes that these procedures exist (although this is not described in Beyda), Beyda also clearly fails to disclose or suggest the remaining claim elements. **The Final Action admits that the claim would be distinct from the prior art if the downloading request actually resulted in deleting the electronic message. As the claim already provides this feature, the rejection must be withdrawn and the claim should be allowed.**

First, there is no disclosure or suggestion in Beyda of “*receiving a request to restore the electronic mail message on the mail server following a completion of the electronic mail downloading procedure*,” as claimed by Applicant. The Action refers to column 8, lines 40-47 in this regard. However, this passage merely reinforces the clear distinctions between the claimed invention and the Beyda reference. This passage describes how, when a user seeks to forward a message with an attachment, but the attachment has not been modified, the forwarded message is transmitted to the local server without the attachment. There is no mention of any kind about receiving a request to restore the previously received e-mail message on the mail server.

Additionally, even under the distorted and inappropriate view that the attachment is the “electronic mail message,” all this passage confirms is that the attachment was never deleted from the mail server. That is, when the user forwards a message with the attachment unchanged, there is no uploading of the attachment because the attachment is already on the mail server.

Still further, there is also clearly no disclosure or suggestion of “*restoring the electronic mail message as though the electronic mail message had not been downloaded from the mail server in response to receiving the request*,” as claimed by Applicant. There is simply no mention whatsoever regarding restoration of downloaded electronic mail messages in even a general sense in the Beyda reference. The relied upon passage (column 8, lines 45-55) makes no mention of message restoration and merely describes how, according to Beyda’s technique, the attachment already stored at the local server is affixed to a message that has been forwarded.

The Final Action alleges that replying to a message (that has been deleted from the mail server) constitutes restoring the electronic mail message. This conclusion is erroneous. A

reply message is merely another message and is not a restoration of the original message. Moreover, the claim recites that restoring the electronic mail message is "as though the electronic mail message had not been downloaded from the mail server in response to receiving the request." Those it is quite clear that the message itself in its original form is restored. A reply message that might include a copy of content corresponding to a previous message is clearly not an example of restoring a message generally, and clearly not example of restoring a message as though it had never been downloaded as claimed.

The features of Applicant's claim 1 are thus distinct from Beyda for various reasons, so Beyda cannot reasonably be concluded as anticipating what is claimed therein. For reasons similar to those provided regarding claim 1, Beyda also fails to disclose or suggest independent claims 15 and 18. The dependent claims respectively depend from the independent claims and thus incorporate these distinct features as well as their separately recited patentably distinct features.

Accordingly, Applicant respectfully requests reversal of the rejection of claims 15-23 under 35 U.S.C. § 102(b) as being anticipated by Beyda.

Dated: Dec. 19, 2008

Respectfully submitted,

By 

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